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1 UNITED STATES PATENT AND TRADEMARK OFFICE
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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* SHAWN E. WIEDERIN, RICHARD G. MOORE, DURAISAMY
9 GUNASEKAR, GREGORY MUMFORD, LONNIE S. CLABAUGH,
10 JON ABEL, and KOLIN G. HOGUE
11

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13 Appeal 2009-007311
14 Application 09/836,589
15 Technology Center 3600
16

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18 Decided:¹ June 11, 2009
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21 Before HUBERT C. LORIN, ANTON W. FETTING, and
22 BIBHU R. MOHANTY, *Administrative Patent Judges*.
23
24 FETTING, *Administrative Patent Judge*.
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26
27

DECISION ON APPEAL

¹ The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Shawn E. Wiederin, Richard G. Moore, Duraisamy Gunasekar, Gregory Mumford, Lonnie S. Clabaugh, Jon Abel, and Kolin G. Hogue (Appellants) seek review under 35 U.S.C. § 134 of a final rejection of claims 1-40, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

We REVERSE.

The Appellants invented a way to charge for directory assistance services. This is done by tracking the number of directory listings that are transmitted to and displayed on a client access device; and preparing billing information based upon the number of directory listings (Specification 4:¶'s [07]-[08]).

The Appellants' invention permits the customer to select the desired information based upon viewing a portion of the information. The capability to view the information partially allows the customer to retrieve accurate data that is reflective of the customer's, and to pay for only those selected directory listings that are actually used (i.e., accessed and viewed). In this manner, the third party data provider is only compensated for the listings that are accessed and viewed by the customer (Specification 15-16:¶ [46]). Thus, the Appellants' invention selects multiple listings for display, each of which has only partial information. The customer must select one or more to view hidden information for each selected to find the entry desired. So there is the additional step of selecting for more information beyond the usual selecting for dialing in conventional directory assistance.

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. A method of charging for directory assistance services that are provided over a packet switched network, the method comprising:

[1] transmitting information associated with a plurality of directory listings to a client access device over the packet switched network in response to a query initiated by a customer;

[2] in response to a selection of more than one of the directory listings from the client access device, transmitting a plurality of listing numbers to the client access device; and

[3] preparing billing information based upon a number of the plurality of listing numbers transmitted to the client access device.

This appeal arises from the Examiner's Final Rejection, mailed November 30, 2006. The Appellants filed an Appeal Brief in support of the appeal on June 20, 2007. An Examiner's Answer to the Appeal Brief was mailed on November 13, 2008. A Reply Brief was filed on December 3, 2008.

PRIOR ART

The Examiner relies upon the following prior art:

Gerszberg	US 6,052,439	Apr. 18, 2000
Shah	US 6,212,506 B1	Apr. 3, 2001
Cox	US 2002/0115431 A1	Aug. 22, 2002

Gale Group, *BOC Expands Directory Options*, 9 BOC Week (Jan. 1992) (hereinafter "Gale Group").

REJECTIONS

Claims 1, 5-9, 13-17, 21-25, 29-33, and 37-40 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Cox, Gerszberg, and Gale Group.

Claims 2-4, 10-12, 18-20, 26-28, and 34-36 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Cox, Gerszberg, Shah, and Gale Group.²

ISSUES

The issue of whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1, 5-9, 13-17, 21-25, 29-33, and 37-40 under 35 U.S.C. § 103(a) as unpatentable over Cox, Gerszberg, and Gale Group hinges on whether the references describe or show that it was predictable to select more than one directory listing from a client access device and transmit a plurality of listing numbers to the client access device in response.

The issue of whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 2-4, 10-12, 18-20, 26-28, and 34-36 under 35 U.S.C. § 103(a) as unpatentable over Cox, Gerszberg, Shah, and Gale Group hinges on the first rejection.

² The statement of the statutory basis for this rejection omits Gale Group from the list of references upon which the rejection is based (Answer 7). That same statement of statutory basis states that the references are applied as they were in the first rejection, however, all of the claims in this rejection depend from claims in the prior rejection. Gale Group was one of the references applied in the prior rejection, and was therefore applied to all of the claims from which the claims in this rejection depend. Thus, we take the Examiner to have included Gale Group in this rejection as well, and its omission is simply a typographic error.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Cox

01. Cox is directed to the provision of directory assistance services to cellular telephone subscribers (Cox ¶ 0001).
02. In prior art directory assistance services, a customer dials an operator and identifies the name and address of a party whose telephone number is desired. The operator then locates the number, using printed directories or a computer database, and provides the number to the customer (Cox ¶ 0003).
03. In the prior art, after determining the telephone number desired by the customer, rather than voicing it to the customer, the directory assistance operator may initiate a call to the desired party (Cox ¶ 0005).
04. Cox, rather than dropping all further involvement with the call, continually monitors the connection established for a predetermined dual tone multi-frequency (DTMF) signal issued by the customer, such as that obtained by pressing the "*" button. If such a signal is detected, the customer is transferred back to a directory assistance operator, who can then provide whatever further assistance is needed (Cox ¶ 0007).
05. The directory assistance service logs, in a billing database, information identifying the customer, the destination number to which the customer is connected, and the date, time and duration

of the customer/destination number connection. This log of information is periodically provided to the cellular carrier, allowing it to bill the customer for the call connected by the directory assistance operator and recoup the associated expense (Cox ¶ 0008).

Gale Group

06. Gale Group is directed to describing how Southwestern Bell was expanding the coverage for its multiple listing directory assistance (Gal Group 1).

07. The technology allows customers to get more than the usual two directory listings per call from directory assistance. In Texas, beyond a customer's monthly free-call or listing allowance, the multiple listings are 30 cents for the first two listings, and 30 cents for each additional listing (Gal Group 1).

Gerszberg

08. Gerszberg is directed to providing automated directory assistance of telephone numbers over a local loop access architecture (Gerszberg 1:6-8).

09. Gerszberg describes how a user initiates a directory assistance transaction by pressing a soft-key on a vision phone/user interface, and then verbally enters a directory assistance query. Gerszberg then processes the natural language query, incorporates the street address from which the directory assistance query was initiated, searches the database, and prioritizes the search results. The results are displayed on the video phone user interface as text (Gerszberg 7:62-8:23).

1 10. Gerszberg describes how the user is provided with the option of
2 selecting a listing from the search results to be automatically
3 dialed (Gerszberg 8:30-32).

4 *Facts Related To Differences Between The Claimed Subject Matter And*
5 *The Prior Art*

6 11. None of the references applied describes selecting more than
7 one directory listing from a client access device and transmitting a
8 plurality of listing numbers to the client access device in response.

9 *Facts Related To The Level Of Skill In The Art*

10 12. Neither the Examiner nor the Appellants has addressed the level
11 of ordinary skill in the pertinent arts of systems analysis and
12 programming, telephone systems, directory assistance systems,
13 directory assistance billing systems, or user interface design. We
14 will therefore consider the cited prior art as representative of the
15 level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261
16 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific
17 findings on the level of skill in the art does not give rise to
18 reversible error ‘where the prior art itself reflects an appropriate
19 level and a need for testimony is not shown’”) (quoting *Litton*
20 *Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163
21 (Fed. Cir. 1985)).

Facts Related To Secondary Considerations

13. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Obviousness

A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that the obviousness analysis is bottomed on several basic factual inquiries: “[1)] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” 383 U.S. at 17. *See also KSR*, 550 U.S. at 406. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416.

“When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 417.

“For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *Id.*

1 “Under the correct analysis, any need or problem known in the field
2 of endeavor at the time of invention and addressed by the patent can provide
3 a reason for combining the elements in the manner claimed.” *Id.* at 420.

4
5 ANALYSIS

6 *Claims 1, 5-9, 13-17, 21-25, 29-33, and 37-40 rejected under 35 U.S.C. §*
7 *103(a) as unpatentable over Cox, Gerszberg, and Gale Group.*

8 Claims 1, 9, 17, 25, and 33 are the only independent claims. Each of
9 these claims requires selecting more than one directory listing from a client
10 access device and transmitting a plurality of listing numbers to the client
11 access device in response.

12 The Examiner found that Cox described the directory assistance
13 process including display and billing, Gerszberg described displaying the
14 numbers, and Gale Group described multiple listings (Answer 4-5).

15 The Appellants contend that none of the references applied describes
16 selecting more than one directory listing from a client access device and
17 transmitting a plurality of listing numbers to the client access device in
18 response (Br. 13-15).

19 The Examiner responded

20 BOC "allows" customers to get more than the usual two
21 directory listings per call from the directory assistance. Two is
22 [a] multiple listing on top of allowing more than the initial two.
23 The examiner maintains that it is implied that if a user is
24 receiving two listings it is in response to some type of selection
25 by the user. The directory assistance would not send unwanted
26 to [sic.] listings to the user.

27 Answer 11. We disagree with the Examiner.

1 None of the references applied describes selecting more than one
2 directory listing from a client access device and transmitting a plurality of
3 listing numbers to the client access device in response (FF 11). The
4 Examiner has not found otherwise, but instead found that there must have
5 been some selection. While we agree there must have been some selection
6 to receive the two listings, this is far from implying that such a selection was
7 from among other directory listings from the client access device, instead of
8 from asking for names from the operator. The Examiner's rationale is that
9 in Gale Group, "[t]wo is [a] multiple listing on top of allowing more than the
10 initial two." *Id.* It is unclear how the Examiner relies on this. If the
11 Examiner means to imply that the additional listings are selected from the
12 first set of listings, nothing in Gale Group states or implies this. Instead,
13 Gale Group simply describes increasing the number of entries that can be
14 retrieved to be more than two.

15 Each of the references states that selections of multiple numbers are
16 based on queries; the selection from among multiple numbers is of a single
17 entry rather than multiple entries. Cox describes conventional directory
18 assistance with a provision allowing the caller to recontact the operator (FF
19 01-04). Gerszberg describes displaying multiple numbers, but selecting one
20 from those numbers (FF 10). Gale Group describes customers getting
21 multiple listings, but again selecting only one (FF 06-07).

22 Thus, we conclude the Examiner has failed to present a *prima facie*
23 case. Since this issue is determinative, we need not reach the remaining
24 Appellants' arguments.

Claims 2-4, 10-12, 18-20, 26-28, and 34-36 rejected under 35 U.S.C. § 103(a) as unpatentable over Cox, Gerszberg, Shah, and Gale Group.

These claims depend from the independent claims in the prior rejection and therefore incorporate the same limitations. Nothing in Shah overcomes the omissions in the Examiner's findings as to the independent claims. Thus, the Examiner has failed to present a prima facie case as to this rejection.

CONCLUSIONS OF LAW

The Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1, 5-9, 13-17, 21-25, 29-33, and 37-40 under 35 U.S.C. § 103(a) as unpatentable over Cox, Gerszberg, and Gale Group.

The Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 2-4, 10-12, 18-20, 26-28, and 34-36 under 35 U.S.C. § 103(a) as unpatentable over Cox, Gerszberg, Shah, and Gale Group.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 1, 5-9, 13-17, 21-25, 29-33, and 37-40 under 35 U.S.C. § 103(a) as unpatentable over Cox, Gerszberg, and Gale Group is not sustained.
- The rejection of claims 2-4, 10-12, 18-20, 26-28, and 34-36 under 35 U.S.C. § 103(a) as unpatentable over Cox, Gerszberg, Shah, and Gale Group is not sustained.

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REVERSED

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